

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 32, 34-47.

The following claims are *independent*: 32.

The following claims have previously been *canceled* without prejudice or disclaimer: 1-31 and 33.

Please *amend* claims 32, 46 and 47; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 32 and 34-47 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Applicant respectfully traverses the rejection(s), and submits that the noted claims all satisfy the requirements of 35 U.S.C. § 112.

Applicant asserts that claims 32 and 34-47 are supported throughout the originally filed specification, drawings and claims. Although Applicant traverses the rejection, Applicant has amended the claim(s) to correct the informalities and further clarify the claim elements. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claim 32 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Galant, US Patent No. 6,839,686 (hereinafter “Galant”) in view of Birle Jr., et al., US Patent Publication No. 2003/0130941 (hereinafter “Birle”). Also, Claims 34-47 are rejected under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Galant in view of Birle and in further view of Official Notice.

Applicant respectfully traverses these rejections and submits that a *prima facie* showing of obviousness has not been established and that the applied references, taken individually or in combination, fail to discuss or render obvious every element of each pending claim. Furthermore, Applicants traverse the Examiner's various instances of Official Notice and respectfully request that, in accordance with MPEP § 2144.03(C), the Examiner provide documentary evidence in support of his position that the claim elements were allegedly well known to one of ordinary skill in the art at the time of Applicants' invention.

The Examiner also cites a third reference, Green, et al., US Patent Publication No. 2003/0093375 (hereinafter “Green”). In the rejection, the Examiner fails to apply Green to the pending claims as amended in the RCE filed February 11, 2010 and instead applies Green to a prior version of the claims. Applicant requests that should the

Examiner maintain the rejection that the Examiner apply references only to the claim elements as currently presented.

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as "Graham factors," which include that "[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved." *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," (§ 2106 II(C), emphasis added) and, "*All words in a claim*

¹ The "[Graham] factors continue to define the inquiry." 550 U.S. 398 (2007).

must be considered in judging the patentability of that claim against the prior art.” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(A)** and/or **(B)**, and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact **missing** at least the following element(s) as recited, *inter alia*, in currently amended independent claim(s) 32:

A unit pricing device, comprising:

...
calculate, based on forward information in the first data structure, convertible note information in the second data structure, equity security financial information in the third data structure, and issuer identifier financial information in the fourth data structure, pricing data associated with the unit comprising the forward transaction and the convertible note.

The Office Action asserts the above claimed elements are shown in Galant (col. 4 , line(s) 4 and 19), alleging "Galant discloses debt and equity securities and structured securities" (Office Action, p. 4, § 3). Applicant submits the Office Action mischaracterized Galant and hereby disagrees with the Examiner's assertion.

Contrary to the Examiner's assertion, Applicant submits that Galant essentially discusses "[a]n apparatus, method and data structure for procuring and analyzing

information, particularly information regarding the financial markets ... in a format that facilitates analysis and decision-making" instead of the claimed elements (Galant, Abstract). Galant describes "an invention which allows one to efficiently obtain and analyze investment information," (Galant, col. 1, lns. 30-31) and further clarifies that "the invention relates to an apparatus, method and data structure for analyzing a variety of debt and equity instruments" (Galant, col. 1, lns. 12-14). Galant goes on to describe that the system is a market analysis tool, as "[t]he invention simplifies the process of analyzing the markets by making the most relevant information available in an easy-to-use, integrated manner" (Galant, col. 1, lns. 50-53). Galant's system ultimately provides financial advice, explaining that it aids "the process of identifying specific analysts and services, obtaining information and compiling investment information, analyzing the information and providing financial advice" (Galant, col. 1, lns. 39-42). Accordingly, Applicant submits that Galant's system of analyzing financial market data is different from at least the claimed elements as recited in independent claim 32.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference; more specifically, Applicant respectfully requests additional clarification as to how and specifically why the Examiner believes Galant's market analysis tool which examines "debt and equity securities and structured securities" (Office Action, p. 4, § 3), is allegedly analogous to and/or renders obvious the claimed elements recited in independent claim 32. Specifically, the Examiner points to sections of Galant that discuss "target[ing] investors based on past preference or current ownership of a particularly

structured security" and "permit[ting] a user the option of creating a debt or equity portfolio - specific to the user's needs - from a database of financial information" (Galant, col. 2, lns. 3-4 and 18-20), which are clearly distinct from the claimed elements.

Similarly, Applicant submits that Birle's disclosure of a "convertible financial instrument" (Birle, Abstract), which the Examiner acknowledged in a previous Office Action dated July 14, 2006, did "not explicitly disclose ... generate, based on said market information and said terms of said proposed unit, pricing data associated with said proposed unit" (7/14/06 Office Action, p. 13) fails to remedy the deficiencies identified above in Galant with regard to independent claim 32. Furthermore, Applicant submits that Green's convertible note simulator that lacks any ability to handle forward settlement data fails to remedy the deficiencies in Galant in view of Birle. For at least the reasons discussed above, Applicant submits that the pending rejection has mischaracterized the language of the claim element(s) and/or the applied reference(s) and, thus, has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Although of different scope than independent claim 32, Applicant submits claims 34-47, which are directly or indirectly dependent on independent claim 32, are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Galant with regard to independent claim 32. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claims.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited

reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 32, 34-47, all: overcome all rejections and/or

objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-455. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-455.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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